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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,197	03/26/2004	Brent R. Jones	D/A2010Q2-US-DIV	2939

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EXAMINER

LIANG, LEONARD S

ART UNIT PAPER NUMBER

2853

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,197	<b>Applicant(s)</b> JONES ET AL.	
	<b>Examiner</b> Leonard S. Liang	<b>Art Unit</b> 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-16, 18-22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, and 23-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/816237. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the co-pending application and is covered by the co-pending application since the co-pending application and the application are claiming common subject matter as shown in the table below.

# 10/816237 Claims	#10/811197 Claims
<p>1. An ink stick for use in a solid ink feed system of a phase change ink printer, wherein the solid ink feed system includes a shaped guide rail, the ink stick comprising:</p> <ul style="list-style-type: none"> <li>a three dimensional ink stick body having a guide surface and a plurality of side surfaces that intersect the guide surface; and</li> <li>a shaped guide element formed in the guide surface of the ink stick body;</li> </ul> <p>wherein at least one of the side surfaces has a predetermined non-planar key shape so that</p>	<p>1. An ink stick for use in a solid ink feed system of a phase change ink printer, wherein the solid ink feed system includes an elongate ink stick feed channel with an elongate shaped guide rail extending in a feed direction, and a key plate covering at least a portion of the ink stick feed channel along the feed direction, wherein the key plate has an insertion opening providing access in an insertion direction into the feed channel, the ink stick comprising:</p> <ul style="list-style-type: none"> <li>a three dimensional ink stick body having</li> </ul>

the ink stick can be inserted in an insertion direction into the solid ink feed system through an opening having a corresponding non-planar key shape;

wherein the shaped guide element is shaped for guiding the ink stick in a feed direction along a defined path in the ink stick feed system;

wherein the feed direction is substantially perpendicular to the insertion direction; and

wherein the shaped guide element has a shape that complements the shape of the shaped guide rail in the solid ink feed system.

7. A method of inserting an solid ink stick into a feed channel of a solid ink printer, the method comprising:

providing an ink stick having an ink stick insertion perimeter, aligning the ink stick insertion perimeter with an insertion opening of a key plate;

inserting the ink stick in an insertion direction through the insertion opening;

aligning a shaped guide element on the ink stick with a guide rail in the feed channel;

moving the ink stick in a feed direction in the feed channel, wherein the feed direction is different from the insertion direction; wherein aligning the ink stick insertion perimeter with the insertion opening comprises aligning at least three non-linear key element shapes; and

wherein at least one of the non-linear key element shapes is oriented at least partially transverse to the feed direction.

an insertion perimeter; and

a non-planar shaped guide element formed in the ink stick body, wherein the guide element is shaped to interact with the elongate shaped guide rail of the solid ink feed system for guiding the ink stick along the guide rail;

wherein the ink stick insertion perimeter is in a plane substantially perpendicular to the insertion direction;

wherein the insertion direction is substantially different from the feed direction; and

wherein the insertion perimeter has at least one perimeter section forming a nonlinear key element that matches in size and shape a nonlinear key element in the perimeter of the key plate insertion opening.

4. The ink stick of claim 1, wherein the insertion direction is substantially perpendicular to the feed direction.

23. A method of inserting an ink stick into an ink feed system, the method comprising:

identifying an ink stick perimeter shape;

matching the ink stick perimeter shape with a correspondingly shaped key plate opening of the ink feed system;

inserting the ink stick in an insertion direction through the key plate opening;

engaging a shaped ink stick guide element on the ink stick with a shaped guide rail in the ink feed system having a shape corresponding to the shape of the shaped ink stick guide element; and

moving the ink stick in a feed direction so that the shaped ink stick guide element engaged with the shaped guide rail guides the shaped ink stick guide element along the shaped guide rail;

wherein the feed direction is different from the insertion direction.

24. The method of claim 23, wherein the

	<p>insertion direction is substantially perpendicular to the feed direction.</p> <p>25. The method of claim 23, wherein inserting the ink stick through the key plate opening comprises inserting the portion of the ink stick having the shaped guide element through the key plate opening before inserting other portions of the ink stick.</p>
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Both the pending and co-pending application claim the same an ink stick for use in a ink feed system which includes a shaped guide rail. Both the pending and co-pending application also claim a shaped guide element in the surface of the ink stick which interacts with the guide rail. Both the pending and co-pending application also claim that the ink stick has a particular key shape that fits through an insertion opening. Both the pending and co-pending application also claim that the feed direction is substantially different (perpendicular) from the feed direction. Both the pending and co-pending application also claim the method steps associated with the above limitations.

Thus both the pending and co-pending application disclose substantially the same subject matter. However, the particular language claiming this substantially same subject matter is somewhat different. Thus an obvious type double patenting rejection is needed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 2-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/816237 in view of Jones (US Pat 6874880).

As shown in the table above, the co-pending application discloses an ink stick substantially similar to the ink stick claimed in the pending application.

However, the co-pending application differs from the claimed invention in that it does not disclose that the insertion perimeter forms a visually recognizable symbol and the at least one perimeter section forms a portion of the visually recognizable symbol. Nor does it disclose that the insertion perimeter forms an alphanumeric character, and the at least one perimeter section forms a portion of the alphanumeric character.

Jones discloses that the insertion perimeter forms a visually recognizable symbol and the at least one perimeter section forms a portion of the visually recognizable symbol and that the insertion perimeter forms an alphanumeric character, and the at least one perimeter section forms a portion of the alphanumeric character (figure 7; claim 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Jones into the invention of copending application 10/816237. The motivation for the skilled artisan in doing so is to gain the benefit of forming an ink stick, which is aesthetically pleasing to the user.

This is a provisional obviousness-type double patenting rejection.

#### *Allowable Subject Matter*

Claims 8-16, 18-22, and 26 are allowed.

#### *Response to Arguments*

The applicant's arguments regarding Loofbourow et al (US Pat 5442387) are persuasive. However, the new double patenting rejection shown above has been made.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S. Liang whose telephone number is (571) 272-2148. The examiner can normally be reached on 8:30-5 Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

08/15/05

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 8/18/05  
**MANISH S. SHAH**  
**PRIMARY EXAMINER**